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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,363	02/23/2000	Jian Ni	PF396P1	4726

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HUMAN GENOME SCIENCES INC
9410 KEY WEST AVENUE
ROCKVILLE, MD 20850

EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT PAPER NUMBER

1642

DATE MAILED: 03/29/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/176,200	NI ET AL.	
	Examiner	Art Unit	
	Sheela J Huff	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-32 is/are allowed.
- 6) ☒ Claim(s) 33-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed on 1/23/02 has been considered. Applicant's arguments are deemed to be persuasive.

Claims 1-46 are pending.

Claims 1-18 are withdrawn from consideration as being drawn to a non-elected invention.

Claims 19-46 are currently under consideration.

All of the outstanding rejections are withdrawn in view of applicant's amendments/arguments.

New Grounds of Rejection

Claims 33-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to provide an enabling disclosure without complete evidence either that the claimed biological materials are known and readily available to the public or complete evidence of the deposit of the biological materials.

The specification lacks complete deposit information for the deposit of hybridoma cell line ATCC Deposit Number 209431. It is not clear that hybridomas possessing the identical properties of ATCC Deposit Number 209431 are known and publicly available or can be reproducibly isolated from nature without undue experimentation.

Exact replication of a cell line is an unpredictable event. Although applicant has provided a written description of a method for selecting the claimed hybridoma cell lines and monoclonal antibodies, this method will not necessarily reproduce antibodies and hybridomas which are chemically and structurally identical to those claimed. It is unclear that one of skill in the art could derive a monoclonal antibody and hybridoma identical to those claimed. Undue experimentation would be required to screen all of the possible antibody and hybridoma species to obtain the claimed antibodies and hybridomas.

Art Unit: 1642

Because one of ordinary skill in the art could not be assured of the ability to practice the invention as claimed in the absence of the availability of the claimed ATCC Deposit Number 209431, a suitable deposit for patent purposes, evidence of public availability of the claimed ATCC Deposit Number 209431 or evidence of the reproducibility without undue experimentation of the claimed ATCC Deposit Number 209431, is required.

Applicant's referral to the deposit of ATCC Deposit Number 209431 on page 10 of the specification is an insufficient assurance that the required deposit has been made and all the conditions of 37 CFR 1.801-1.809 met.

If the deposit is made under the provisions of the Budapest Treaty, **filing of an affidavit or declaration by applicant or assignees or a statement by an attorney of record who has authority and control over the conditions of deposit over his or her signature and registration number stating that the deposit has been accepted by an International Depository Authority under the provisions of the Budapest Treaty and that all restrictions upon public access to the deposited material will be irrevocably removed upon the grant of a patent on this application.** This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves this specific matter to the discretion of each State.

Applicant's attention is directed to *In re Lundak*, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR 1.801-1.809 for further information concerning deposit practice.

Conclusion


Claims 19-32 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-7866. The examiner can normally be reached on M,Th 5:30 am-2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Art Unit: 1642

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Sheela J Huff
Primary Examiner
Art Unit 1642

sjh
March 28, 2002